KAREN P. HEWITT
United States Attorney
STEVE B. CHU
Assistant U.S. Attorney
California Bar No. 221177
Office of the U.S. Attorney
880 Front Street, Room 6293
San Diego, California 92101
Telephone: (619) 557-5682

Attorneys for Defendant
United States of America

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF CALIFORNIA

ALTON B. HORNBACK, Plaintiff, v. UNITED STATES OF AMERICA, Defendants.	Civil Case No. 08 CV 0127-JLS-AJB THE UNITED STATES' REPLY BRIEF IN SUPPORT OF MOTION TO DISMISS Date: June 9 , 2008 Time: 11:00 a.m. Crtrm: 6 Judge: Hon. Janis L. Sammartino [No Oral Argument Unless Requested by the Court]

I

INTRODUCTION

On May 5, 2008, Respondent, United States ("Government" or "USPTO"), moved to dismiss Hornback's Petition for Writ of Mandamus, on the grounds that: (1) Hornback has not established that this Court has jurisdiction over his Petition; and (2) Hornback cannot prove that he is entitled to the drastic remedy of mandamus relief. In his Opposition, Hornback again fails to cite a statute in which the Government waived its sovereign immunity. He also admits that he failed to follow USPTO rules for submitting substitute claims. Thus, he cannot justify his refusal to pursue avenues of relief available to him at the USPTO on the grounds that the alleged errors in his patent were not his fault. Therefore, because Hornback has failed to pursue administrative remedies available to him at the USPTO, and has otherwise not established that this Court has jurisdiction, his Petition should be dismissed.[1/]

II

ARGUMENT

A. THIS COURT LACKS SUBJECT MATTER JURISDICTION OVER HORNBACK'S CLAIMS

Hornback has not established that this Court has jurisdiction over his Petition. In its Motion, the Government established that a writ of mandamus cannot be used to order the Director to exercise his discretion. Motion at 10. In his response, Hornback did not dispute that argument.

Furthermore, Hornback has not cited a statute in which the Government waived its sovereign immunity. Id. In his Opposition, Hornback points to 35 U.S.C. § 131. Opp. at 2. But that statute, styled "Examination of application," applies to examining patent applications and has nothing to do with correcting an issued patent.

B. HORNBACK IS NOT ENTITLED TO MANDAMUS RELIEF

In his Opposition, Hornback again argues that he has exhausted his administrative remedies. Opp. at 2. First, he alleges that the reissue statute, 35 U.S.C. § 251, is "NOT

[1/] Hornback has filed multiple lawsuits in connection with his missile guidance system and its corresponding patent. Hornback initially pursued litigation in the Federal Court of Claims, then turned to the Southern District of California after his cases were dismissed and he was forbidden from pursing any further litigation in that Court. The cases he has filed in this district include the following: Hornback v. United States, Case No. 07cv0289-JLS-AJB (S.D. Cal. Feb. 13, 2007); Hornback v. United States, Case No. 07-CV-01694 JLS-AJB (S.D. Cal. Aug. 28, 2007); Hornback v. United States, Case No. 06cv2113-BEN-AJB (S.D. Cal. Sept. 29, 2006) (dismissed); Hornback v. United States, Case No. 06CV0825-BTM(RBB) (S.D. Cal. Aug. 15, 2006) (dismissed); Hornback v. United States, Case No. 05CV2184-JM(AJB) (S.D.Cal. Mar.7, 2006) (dismissed); Hornback v. United States, Case No. 04CV0339-WQH(WMc) (S.D. Cal. Aug. 4, 2004), aff'd, 127 Fed. Appx. 964, 2005 WL 844627 (9th Cir. Apr. 13, 2005) (unpublished), cert. denied, 126 S. Ct. 665 (2005); Hornback v. United States, Case No. 94CV0952-IEG(LSP) (S.D. Cal. Sept. 21, 1995), aff'd, 91 F.3d 152, 1996 WL 368135 (9th Cir. June 28, 1996) (unpublished); Hornback v. United States, Case No. 89CV1914-R(M) (S.D. Cal. Oct. 2, 1992), aff'd, 16 F.3d 422, 1993 WL 528066 (Fed. Cir. Dec. 22, 1993) (unpublished), cert. denied, 511 U.S. 1070 (1994)

Applicable." Opp. at 2.[2/] Specifically, he claims that 35 U.S.C. § 251 only applies "where the errors in the patent were the fault of the patentee, not the PTO." Id. at 2-3.

Assuming Hornback is correct, that reissue can only be used to correct errors that were the fault of the patentee, that option is still available to Hornback. In his Opposition, Hornback admits that the alleged errors in his patent were his own fault. Specifically, Hornback acknowledged that when he filed the second amendment, the one giving rise to the alleged error in his patent, he failed to follow rules for substituting claims. Id. at 4, 8. Quoting at length the Government's analysis of the rules for submitting substitute claims (Motion at 17-18), he admits that "he did, indeed, fail to number amended claims 3-6 as new claims 7-10 ," as required. Id. at 8. Thus, even under Hornback's reading of the reissue statute, he is qualified to file a proper request for a reissue. Consequently, his excuse for not pursuing this avenue of relief available to him at the USPTO is unjustified. And it is worth noting that the USPTO has repeatedly stated that reissue is the most appropriate vehicle for Hornback to attempt to correct the claims of his issued patent.[3/] Thus, reissue is an avenue of relief still available to Hornback should he choose to pursue it.

Hornback further notes that the "PTO Refused to Reissue" his patent and returned his check. Opp. at 3. But in doing so, he failed to dispute, much less address, the Government's contention that he "had not submitted anything resembling a proper request for a reissue of his patent." Motion at 14. In this same vein, Hornback argues that the USPTO erred in finding that his amendments might broaden his claims, and would therefore, be improper. Opp. at 3. But that debate is premature; it is an issue for an examiner to decide only if Hornback files a proper reissue application. Motion at 14-15.

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[2/] Throughout this Reply, Petitioner's Opposition to Respondent's Motion to Dismiss is referred to as "Opp. at __."

[3/] The USPTO has not suggested that it can guarantee that his reissue application will issue as a patent, but only represents that reissue is the appropriate avenue for Hornback to pursue to correct the claims of his issued patent.

Hornback admits that his issued patent contains claims "identical" to those in the first May 1987 amendment,[4/] which supports the Government's contention that only those claims were reviewed by the examiner and deemed patentable. Opp. at 4. Nevertheless, Hornback contends that the examiner in fact "allowed" the second, later-filed version of claims 3-6.[5/] Id. In support, Hornback points to the Examiner's response of June 11, 1987, in which the Examiner noted receipt of the "communication" containing the second amendment. Id.

But the USPTO's receipt of that filing is not the issue; the question is whether the USPTO examined the claims contained within that second communication. As described in the Government's motion, the record shows that it did not examine those claims due to the confusion caused by Hornback's misnumbering of the claims. Motion at 17-18. Specifically, rather than number the second version of claims, as 7-10, Hornback repeated the numbering he used in the first amendment, assigning both sets the numbers 3-6. As a result, the second version of claims 3-6 were marked "duplicate," and were never examined. Instead, the USPTO examined and allowed the first version of claims 3-6. Id. As Hornback acknowledges, in submitting the second set of claims, Hornback failed to follow the procedural rules designed to avoid just such confusion. Id.

Finally, Hornback seems to argue that he has been unable to enlist the aid of a competent patent attorney because his application was under a secrecy order. Opp. at 5-7. But that order was lifted on April 21, 1999. Since at least that time, Hornback was free to seek assistance of counsel without violating his duties of secrecy. Thus, he simply has no excuse for failing to hire competent counsel to represent him before the USPTO in connection with his efforts to correct perceived errors in his patent.

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[4/] The document is dated May 1, 1987, and the USPTO stamp indicates that it was received by the USPTO on May 4, 1987.

[5/] The document is dated May 6, 1987, and the USPTO stamp indicates that this document was received by the USPTO on May 11, 1987.

III

CONCLUSION

Hornback's Petition should be dismissed because he has not established that the Court has jurisdiction to consider it. Moreover, he is not entitled to mandamus relief because he has not pursued all other options of relief available to him before the USPTO.

DATE: May 29, 2008

KAREN P. HEWITT
United States Attorney

/s Steve B. Chu
STEVE B. CHU
Assistant U.S. Attorney
Attorneys for Respondent
United States of America

Of Counsel:

JOHN FARGO
Director

SUSAN L. C. MITCHELL
Assistant Director
Commercial Litigation Branch
Civil Division
Department of Justice
Washington, D. C. 20530

THOMAS L. STOLL
WILLIAM LaMARCA
Associate Solicitors
OFFICE OF THE SOLICITOR-USPTO
600 Dulaney Street, Madison West, 8C43
Alexandria, VA 22314
Tel: (571) 272-9035
Fax: (571) 273-0373